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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/295,856	04/21/99	COLLART	T IACTP005

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TM02/0409

EXAMINER

RODRIGUEZ, P

ART UNIT

PAPER NUMBER

2121

DATE MAILED:

04/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	<b>Application No.</b> 09/295,856	<b>Applicant(s)</b> COLLART, TODD R.	
	<b>Examiner</b> Paul L Rodriguez	<b>Art Unit</b> 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- |  |  |
|--|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                   | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>14</u> . | 20) <input type="checkbox"/> Other:  |

### **DETAILED ACTION**

1. The Preliminary amendment filed 12 March 2001 has been received and considered.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 March 2001 has been entered.

#### ***Information Disclosure Statement***

3. The Information Disclosure Statement filed 12 March 2001 contained many references that were previously cited on the PTO-892s from the office action of March 2000 and December 2000 and the PTO-1449s that were submitted by the applicant. Examiner has lined through the references that were previously considered prior to this action and have considered the new references cited on the IDS filed 12 March 2001.

#### ***Specification***

4. The abstract of the disclosure is objected to because of failing to comply with 37 CFR §1.72(b). The word length of the abstract, for consistency with PCT, is required not to exceed 150 words, replacing the MPEP § 608.01(b) range of 50-250 words.
5. The disclosure is objected to because of the following informalities: page 56 lines 10-11, following amendment A now recites "...are tested in the below herein."

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-5 and 11-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 1 recites the limitation "the tracking identifier" in claim 1 lines 10-11. The tracking identifier could refer to either the "electronic storage medium tracking identifier" or the "package tracking identifier"; there is insufficient antecedent basis for this limitation in the claim.

9. Claim 1 recites the limitation "the tracking information" in claim 1 lines 13-14. The tracking information could refer to either the tracking information of step (e) or step (c), which are considered different by the examiner, there is insufficient antecedent basis for this limitation in the claim.

10. Claim 11 recites the limitation "the tracking information" in claim 11 line 15. The tracking information could refer to either the tracking information of the medium or the package, there is insufficient antecedent basis for this limitation in the claim.

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11. Claims 12-18 recites the limitation "providing a response to use of an electronic storage medium having a tracking identifier incorporated thereon" in claims 12-18 lines 1-3. Base claim 11 transmits tracking information to the server derived from the package and never transmits the identifier or the information derived or read from the electronic storage medium. Therefore, claims 12-18 would never be able to have the server provide a response based on the use of the electronic storage medium having a tracking identifier because only the tracking information from the package was transmitted to the server. There is insufficient antecedent basis for this limitation in the claim.

12. Due to the number of 35 USC § 112 second paragraph rejections, the examiner has provided a number of examples of the claim deficiencies in the above rejection(s), however, the list of rejections may not be all inclusive. Applicant should refer to these rejections as examples of deficiencies and should make all the necessary corrections to eliminate the 35 USC § 112 second paragraph problems and place the claims in a proper format.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

14. Claims 1-5 and 11-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Brindze et al (U.S. Pat 5,822,291). The claimed invention reads on Brindze et al as follows:

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Brindze et al discloses a method (and program) for tracking the distribution of content electronically (col. 3 lines 35-38), comprising the steps of: (a) incorporating an electronic storage medium tracking identifier onto an electronic storage medium (reference number 24, col. 1 lines 53-61, col. 3 line 39 – col. 4 line 33), (b) incorporating a package tracking identifier onto a package in which the electronic storage medium is stored (col. 5 lines 8-33), (c) storing tracking information in a database (reference number 48, col. 11 lines 53-61, col. 12 lines 1-18), (d) detecting the tracking identifier when the electronic storage medium is accessed by a computer (col. 1 lines 53-61, col. 3 line 39 – col. 4 line 33, col. 7 lines 45-52), (e) transmitting, as a function of the tracking identifier having been detected, tracking information to a server computer (col. 7 lines 45-66), (f) determining, as a function of the tracking information having been transmitted to the server computer, appropriate updated information utilizing logic in the server computer to transmit to the computer (col. 7 lines 52-58), wherein the server computer performs a table lookup to determine a retailer that sold the package (col. 11 line 53 – col. 12 line 33), wherein the server computer performs a table lookup to determine one or more authorized titles (col. 9 lines 25-49), wherein the server computer transmits an information banner to the computer (col. 7 lines 52-56, col. 9 lines 15-24, it would be obvious to display the promotions as a banner, pop up window or any other appropriate means of displaying the item), wherein a transaction is written to a database memorializing processing (col. 5 lines 1-7, col. 9 lines 35 – col. 10 line 20 and col. 12 lines 1-18) a program embodied on a computer readable medium for identifying and providing a response to the use of an electronic storage medium having a tracking identifier incorporated thereon, and a package having a tracking identifier thereon (Figures 2, 4 and 5), a code segment that reads the tracking identifier of the electronic

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storage medium upon being input into a computer by a user (reference number 140), a code segment that detects, as a function of the tracking identifier, tracking information when the package is accessed by a computer (col. 8 lines 8-33, obvious that the vendor apparatus would contain firmware and/or software to perform functions), a code segment that transmits the tracking information to a server computer (reference number 124), a code segment in the server computer that determines, as a function of the tracking information, appropriate updated information to transmit to the computer (col. 7 lines 52-58), wherein the server computer initiates authorized playback of authorized information utilizing a transaction from the server computer (col. 12 lines 1-18), including a code segment that receives live update information from the server computer (col. 5 lines 52-58, col. 9 lines 15-24) and including a code segment that posts indicia of video user information, and a suitable player to a database (col. 5 line 57 – col. 6 line 6, col. 7 lines 52-58).

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brindze et al (U.S. Pat 5,822,291) in view of Takahashi (U.S. Pat 5,878,020).

Brindze et al teaches most of the instant invention as applied to claims 1-5 and 11-18 above and also teaches an apparatus for tracking the distribution of content electronically (col. 3 lines 20-38), the digital code representative of a tracking identifier of content on the optical disc

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electronic storage medium (col. 3 lines 39-col. 4 lines 33), the apparatus including logic that detects the tracking identifier when the electronic storage medium is accessed by a computer (reference number 20), the apparatus including logic that transmits, as a function of the tracking identifier, tracking information to a server computer (reference number 28), and the apparatus including logic in the server computer that determines, as a function of the tracking information, appropriate updated information to transmit to the computer (reference number 40, col. 4 lines 62 - col. 5 line 7).

Brindze et al fails to teach an optical disc electronic storage medium having a burst cut area and a digital code stored in the burst cut area;

Takahashi teaches an optical disc electronic storage medium having a burst cut area (Abstract, figure 15, figure 21, col. 20 lines 32-65) and a digital code stored in the burst cut area (figure 15, figure 21, col. 20 lines 32-65).

Brindze et al and Takahashi are analogous art because Brindze et al is a system for reading information stored in an auxiliary area on a mass storage device such as an optical disc and Takahashi provides the method for recording information on an optical disc.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the Burst Cut Area of Takahashi in the optical storage device of Brindze et al because Takahashi teaches increased speed for file management of mass storage devices such as an optical disc (col. 1 line 63 – col. 3 line 58).

### ***Response to Arguments***

17. Applicant's arguments filed 12 March 2001 have been fully considered but they are not persuasive.



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Regarding applicant arguments with respect to 35 USC § 112 rejections. The rejection of claims 1 and 6 due to "the tracking information" was corrected by Amendment B, however a new deficiency was introduced with this same limitation. The rejection of claims 2, 7 and 12 are withdrawn and the deficiencies have been corrected.

18. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Alexander et al (U.S. Pat 6,134,593) – Utilizes the Internet and a server to authorize a user access to software based on a payment of a fee.

Knowlton et al (U.S. Pat 6,061,057) – Teaches client server business transactions that provide a tracking number on a CD that is purchased. The CD and package contain a distribution identifier that provides the ability for a vendor to track any number of products according to any number of distribution methods.

Reber et al (U.S. Pat 5,930,767) – Provides a system that identifies information about an item such as a CD or DVD and records transaction information in a server.

Laurash et al (U.S. Pat 5,413,383) – Provides a multipurpose label for a package that contains various data and various data formats for tracking the distribution of an item.

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20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L Rodriguez whose telephone number is (703) 305-7399.

The examiner can normally be reached on 6:30 - 4:00 M-Th and alternate F.

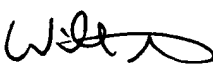
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Grant can be reached on (703) 308-1108. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3718 for regular communications and (703) 305-3718 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Paul L Rodriguez  
Examiner  
Art Unit 2121

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March 29, 2001

  
WILLIAM GRANT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100  
4/5/01